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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,530	01/16/2001	Mireille Maubru	05725.0828-00	2122

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/16/2002 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,530

Applicant(s)

MAUBRU ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 13,15,23-29 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,14,16-22 and 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 15 April 2002 is entered. Claims 30 and 33 are amended. Claims 1-44 are pending. Claims 13, 15, 23-29, and 37-44 are withdrawn from consideration as not reading on the elected invention. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

Applicant is advised that should claim 1 be found allowable, claims 35 and 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof as stated previously.

Response to Amendment

The rejection of claims 1, 35, and 36 under 35 USC 112, 2nd paragraph, due to the phrase "fatty acid soaps" is withdrawn. The amendment to the specification clarifies the meaning of the phrase.

The rejection of claims 30 and 33 under 35 USC 112, 2nd paragraph, due to typographical errors is withdrawn. The amendments to the claims obviate the rejection.

Response to Arguments

The rejection of claim 12 under 35 USC 112, 2nd paragraph, due to the term "derivatives" is withdrawn. Applicant argues that the definition on page 16, lines 12-18, provides reasonable clarity to the term. Applicant's argument is convincing.

Claims 1-12, 14, 16-22, and 30-36 are rejected under 35 USC 112, 2nd paragraph, for reasons as indicated previously.

Claims 1, 35, and 36 are rejected due to the definition of R" as "chosen from a hydrogen atom and alkyl groups comprising 1 to 18 carbon atoms". Applicant argues that the phrase is unambiguous in that R" can comprise from 1 to 18 carbon atoms as well as additional elements or constituents not expressly recited in the claim. However, the rejection is maintained because it is ambiguous whether or not a chain of 19 carbon atoms is encompassed by the definition of R". If so, then the definition of R" is meaningless, since R" has no upper limit on the number of carbon atoms, and the limitation of 18 carbon atoms merely serves to obscure this fact.

Claim 33 is rejected for being confusing by including fatty acids where independent Claim 1 states the proviso that the compositions be free of fatty acid soaps. Applicant argues that there is no inconsistency by referring to the amended definition of fatty acid soap. The Examiner understands applicant's argument to be that fatty acids and fatty acid soaps are different. However, claim 1 requires modified starches containing an M group, which can be an alkali metal or an alkaline-earth metal. When a fatty acid is added to a composition containing an alkali metal or alkaline-earth

metal, it would necessarily form at least some amount of fatty acid soap. Therefore, the inclusion of fatty acid according to claim 33 appears to be inherently inconsistent with claim 1.

Any remaining claims are rejected for depending from indefinite base claims.

Claims 1-10, 19-22, 30-32, and 35-36 are rejected under 35 USC 103(a) as being unpatentable over Villa et al (US Pat. 6,001,344) in view of Sweger et al (US Pat. 5,482,704) for reasons as stated previously.

Applicant argues that there is no motivation to combine Villa and Sweger because Villa does not mention amphoteric starches. In response to applicant's arguments against Villa individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that there is no motivation to combine Villa and Sweger because Sweger does not teach the use of modified starches in the exact compositions of Villa. In response to applicant's argument that Sweger fails to teach the use of modified starches in the specific compositions of Villa, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, the teachings of Sweger suggest the substitution of modified starches for Carbopol® in order to benefit from the improved properties of the modified starches.

Applicant argues that Sweger does not teach that Cepa-starch is superior to Carbopol® because Example II of Sweger compares different concentrations of Cepa-starch and Carbopol® as well as a secondary emulsifier. Therefore, applicant argues that the comparisons of Sweger are limited to the exact compositions compared, and cannot be extrapolated to anything else. However, Sweger clearly states "The viscosity studies indicate that the CEPA potato starch Sample (A) is relatively stable over time and is actually superior to the Carbopol standard (Control 2)" (see col. 9, lines 1-3). As noted above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Therefore, the conclusion that CEPA-starch has superior properties compared to Carbopol is not merely an assertion by the Examiner, but rather has clear experimental support in the form of direct comparisons in the prior art.

Applicant argues that the combination of Villa and Sweger fails to demonstrate a reasonable expectation of success and would render the prior art unsatisfactory for its intended purpose. Applicant further argues that neither reference provides direction or guidance to allow one to successfully modify the Villa compositions. In response, it is

noted that the expectation of success is not required to be absolute. The mere assertion by applicant that such a substitution would not work is unconvincing in the face of a clear teaching in the art of the validity of a switch of CEPA-starch for Carbopol. With a respect to a lack of guidance, Sweger clearly gives guidance in the direct comparison as demonstrated in Example II.

Claims 1-12, 14, 16-18, and 35-36 are rejected under 35 USC 103(a) as being unpatentable over Murray (US Pat. 5,720,964) in view of Sweger et al (US Pat. 5,482,704) for reasons as stated previously.

Applicant's arguments are similar to the arguments presented above with respect to Villa and Sweger. In particular, applicant argues that there is no motivation to combine Murray and Sweger and that there is no expectation of success.

In response, the fact that Murray fails to teach modified starches is moot in view of the fact that the rejection is based on the combination of references rather than either reference alone. Furthermore, bodily incorporation of the references is not required. Rather, the rejection is based on what the combination of references suggests to one of skill in the art. In the instant case, the references suggest the desirability of substituting CEPA-starch for Carbopol. Finally, it is noted that the expectation of success is not required to be absolute. The mere assertion by applicant that the combination would not work is not convincing in the face of a clear teaching in the prior art of the desirability of using CEPA-starch in place of Carbopol.

Claims 1 and 33-34 are rejected under 35 USC 103(a) as being unpatentable over Saint-Leger (US Pat. 5,919,438) in view of Sweger et al (US Pat. 5,482,704) for reasons as stated previously.

Applicant's arguments are similar to the arguments presented above with respect to Villa or Murray in view of Sweger. In particular, applicant argues that there is no motivation to combine the references and that there is no expectation of success.

In response, the fact that Saint-Leger fails to teach modified starches is moot in view of the fact that the rejection is based on the combination of references rather than either reference alone. Furthermore, bodily incorporation of the references is not required. Rather, the rejection is based on what the combination of references suggests to one of skill in the art. In the instant case, the references suggest the desirability of substituting CEPA-starch for Carbopol. Finally, it is noted that the expectation of success is not required to be absolute. The mere assertion by applicant that the combination would not work is not convincing in the face of a clear teaching in the prior art of the desirability of using CEPA-starch in place of Carbopol.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

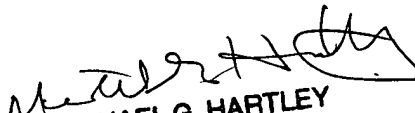
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alternate Mon. and Tues. to Fri. from 9am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1617

July 12, 2002


MICHAEL G. HARTLEY
PRIMARY EXAMINER